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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/744,271 01/22/01 SAKO

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EXAMINER

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ART UNIT PAPER NUMBER

1617

DATE MAILED:

07/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Best Available Copy

Office Action Summary

Application No.

09/744,271

Applicant(s)

SAKO ET AL.

Examiner

Helen Nguyen

Art Unit

1617

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/22/2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 20) ☐ Other:

DETAILED ACTION

The claimed priority of this application to a 371 of PCT/US98/15852, filed on July 30, 1998, is acknowledged.

Claims 1-10 are presented for examination.

The undersigned Examiner supports the goal of the Office to advance prosecution as expediently as is reasonably possible. Co-operation is requested with respect to the timely submission of any references deemed pertinent to the present application along with Form PTO-1449.

Abstract objection

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Specification objection

The disclosure is objected to because of the following informalities:

In the specification on page 3, line 25, page 5, line 6, page 6, line 20 and page 17, line 16, the terms "copolymers, Pemulen, square, among" are misspelled.

Appropriate correction is required.

Claim rejection

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claims 1 and 3 are rejected under **35 U.S.C. 102(b)** as being anticipated by Karlen et al. (US Patent No. 6,004,545).

Karlen et al. teach hair cleansing compositions comprising copolymers of carboxylic acid such as Carbopol-1342 (column 6, line 62), an amphoteric conditioning polymer such as Merguat Plus 3300, (see column 7, line 55), aqueous carriers (water) (column 8, line 58) and silicon compounds (column 6, lines 11-13).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- Claims 1-10 are rejected under **35 U.S.C. 103(a)** as being unpatentable over Karlen et al. (US Patent No. 6,004,545) in view of Hitchen (US Patent No. 6,106,816), Kang et al. (WO 97/23194) and Rath et al. (US Patent No. 5,993,792).

Karlen et al. teach hair cleansing compositions comprising copolymers of carboxylic acid such as Carbopol-1342 (column 6, line 62), an amphoteric conditioning polymer such as Merguat Plus 3300, (see column 7, line 55), aqueous carriers (water) (column 8, line 58) and silicon compounds (column 6, lines 11-13).

Karlen et al. do not teach a humectant, a viscosity modifier, a visible particle, an UV absorber, an optical brightener, an herbal extract and conditioning agents.

Hitchen teaches shampoo compositions comprising cationic polymeric conditioning agents such as Merquat 100 (column 4, line 37 and column 5, line 8). Copolymers of carboxylic acid such as Carbopol 1342 (abstract, column 3 line 63), aqueous carriers (water) and a silicone compound are also disclosed (abstract).

Kang et al. teach shampoo compositions comprising visible particles such as Unisphere (page 9, lines 4-6), a humectant, viscosity modifiers such as thickeners (page 13, lines 20-21) for stabilizing and ensuring the homogeneous dispersion of a hair cleansing compositions (abstract). Copolymers of carboxylic acid such as Carbopol-1342, an aqueous carrier (water) (page 13, lines 5-6) and silicon compound are also disclosed (page 4, line 24).

Rath et al. teach shampoo and conditioner compositions comprising an optical brightener such as shine enhancers, herbal extracts and UV absorbers (column 2, lines 24-28, example 14). Viscosity modifiers such as a thickening composition are also disclosed (abstract).

It would have been prima facie obvious to a person of ordinary skill in the art at the time the invention was made to add Merquat 100 to the composition of Karlen et al. to achieve the beneficial effect of an additional conditioning agent in view of Hitchen and to further add visible particles, a humectant and viscosity modifiers of Kang et al. to the composition of Karlen et al. to achieve the beneficial effect of stabilizing and ensuring the homogeneous dispersion of a hair cleansing compositions.

As to other claimed "...further comprising..." ingredients, it would have been prima facie obvious to a person of ordinary skill in the art to further include such

compounds in the obvious composition to achieve the extra beneficial effect of these additives in view of Rath et al.

See In re Kerkhoven 205 USPQ 1069. The combination of agents, each of which is known to be useful individually for the same purpose, into a single composition useful for the very same purpose, here, *hair cleansing*, is prima facie obvious. At least additive therapeutic effects would be reasonably expected.

As to the claimed weight percent, it is within the skill in the art to select optimal parameters such as ratios or weight percents of components in order to achieve a beneficial effect. See In re Boesch, 205 USPQ 215 (CCPA 19880). Therefore, the ratios or weight percents instantly claimed are not considered critical absent evidence showing unexpected and superior results.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

- Claim 5 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 2 of copending Application No. 09/744,269. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 09/744,269 in view of Kang et al. (WO 97/23194).

Claim 1 of this application claims a hair composition comprising copolymers of carboxylic acid.

Kang et al. teach a hair composition comprising copolymers of carboxylic acid and visible particles such as Unisphere to provide excellent conditioning and esthetic effects for the hair (abstract and page 9, lines 4-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Unisphere to claim 1 to achieve the beneficial effect of providing excellent conditioning and esthetic effects for the hair. Thus, claim 1 of the copending Application No. 09/744,269 encompasses the obvious combination. This is a provisional obviousness-type double patenting rejection.

Claims 1-10 are rejected.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen Nguyen whose telephone number is (703) 605-1198. The examiner can normally be reached on M-F (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Edward J. Webman can be reached on (703) 308-4432 or supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 305-3592 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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Art Unit: 1617

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Helen Nguyen
Patent Examiner

June 29, 2001



EDWARD J. WERMAN
PRIMARY EXAMINER
GROUP 1500